UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KILPATRICK TOWNSEND & STOCKTON LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER
DANNEMAN, PAUL

ART UNIT	PAPER NUMBER
3627	

NOTIFICATION DATE	DELIVERY MODE
06/04/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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jlhice@kilpatrick.foundationip.com

	Application No.	Applicant(s)
Office Action Summary	10/696,014	ARTHUR, STEVEN E.
	Examiner	Art Unit	
	PAUL DANNEMAN	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 April 2010_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) _1,3-8,11,12,15,16 and 19-23_ is/are pending in the application.

    5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) _1,3-8, 11-12, 15-16 and 21-23_ is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 03-11)   **Office Action Summary**   Part of Paper No./Mail Date 20120524

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 April 2010 has been entered.

Response to Amendment

1.   Claims 1, 11, 16, 19, 20 and 21 have been amended.

2.   Claim 23 is newly added.

3.   Claims 2, 9, 10, 13, 14, 17 and 18 have been cancelled.

4.   Claims 1, 3-8, 11-12, 15-16 and 19-23 are pending and have been examined in this Office Action.

Response to Arguments

5.   Applicants' arguments are directed to the amended claims. The Examiner's responses are in the following rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-5, 6-8, 16 and 19-20 are directed to methods. One tool for assisting in determining whether the claimed invention is directed to a statutory process under 35 USC 101 is the "machine-or-transformation" test. If a claimed method meets the "machine-or-transformation" test, the method is

likely patent-eligible under 35 USC 101 unless there is a clear indication that the method is directed to an abstract idea. If a claimed method does not meet the "machine-or-transformation" test, the claim will be considered directed to a non-statutory process unless there is a clear indication that the method is not directed to an abstract idea.

An analysis of method claims using the "machine-or-transformation" test seeks to determine whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. In addition, mere field of use limitations or limitations reciting insignificant extra-solution activity will not transform an unpatentable process into a patentable one as the machine or transformation must impose meaningful limits on the method claim's scope. This means that reciting a particular machine or transformation in an insignificant step (e.g. data gathering, outputting, displaying, receiving, and the like) will not move to make an unpatentable process patentable.

In the instant case, **independent claims 1, 6 and 16** lack any recitation of structure, let alone a recitation which creates a substantial tie so as to impose meaningful limitations on the claim scope. The steps *entering, calculating, comparing, communicating, determining and activating* are not tied to any machine nor do they transform an underlying article to a different state or thing. Accordingly, these claims fail to pass the "machine-or-transformation" test. Further, to the analysis as to whether the claims recite a statutory process under 35 USC 101, there is nothing of record which clearly indicates that the method recited is not directed to an abstract idea. Accordingly, these claims fail to set forth a statutory process under 35 USC 101.

Claims 3-5 which depend from Claim 1, Claims 7-8 which depend from Claim 6 and Claims 19-20 which depend from Claim 16 fail to remedy these deficiencies, thus Claims 1, 3-5, 6-8, 16 and 19-20 are considered to be directed to non-statutory processes.

Allowable Subject Matter

Claims 11, 12 and 15 would be allowable if the § 101 rejection of independent Claim 11 is remedied. Claim 11 should positively recite **"an activation computer programmed to"** receive from a POS device and communicate to a POS device a signal indicating a validation or non-validation of the activation request.

Claims 16, 19-20 would be allowable if the § 101 rejection of independent Claim 16 is remedied. Claim 16 recites "entering a first card number into said POS device" and as stated in the § 101 rejection does not pass the "machine-or-transformation" test. The POS device represents an "insignificant extra solution". The "entering a first card number" should be performed by a "bar-code scanner".

Claim Rejections - 35 USC § 103

6.   **Claims 1 and 3-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein et al., US 7,028,896 B2 ("Goldstein") in view of Risafi et al. US 6,473,500 B1 ("Risafi") and further in view of SEHR, US 2001/0018660 A1.

Claim 1:

With regard to the following limitations:

- *Entering a first gift card number in a series of cards into a POS device;*
- *Entering a last gift card number in the series of cards into the POS device;*
- *Calculating a calculated number of cards in the series based on the first gift card number and the last gift card number;*
- *Comparing the entered total number of cards with the calculated number of cards to confirm if they match;*
- *If the entered total number of cards matches the calculated number of cards activating the card corresponding to the first card number; and*
- *Activating the next successive n-1 cards after the first card number.*

Goldstein does not specifically disclose activating gift card set at a POS device; however Goldstein in at least Column 1, lines 55-67 discloses that a customer may purchase large groups of transaction cards from a card manufacturer so there are no unexpected, duplicate or missing cards. Goldstein in at least Column 2, lines 21-33 further discloses that the cards may be arranged and packaged in a specific sequence to allow for easier batch activation of cards. Goldstein in at least Column 3, lines 19-45 discloses that a retailer may easily identify and activate multiple cards at one time since the cards may be provided in contiguous sets (e.g. bundle, sleeve, etc.) of cards and/or in a known sequence. As a result, the retailer may retrieve an entire set of cards and activate all the cards at once **without having to individually activate each card**. Goldstein in at least Column 12, lines 4-49 discloses that cards which are batched together in sleeves are **sequential numbered**.

Goldstein in at least Column 14, lines 45-67 and Column 15, lines 1-41 discloses reading the identifier of the first and last cards in a sleeve to determine if there are any missing, duplicate or out of sequence cards in the sleeve.

Risafi in at least Column 4, lines 61-67, Column 5, lines 1-10, Fig. 5b, Fig. 7b, Column 6, lines 37-46, Column 8, lines 53-54, Column 9, lines 9-19, lines 35-41 discloses the batch activation of a set of cards at a merchant terminal (POS, ATM, etc.). Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to combine the well-known features of Goldstein for producing and packing cards in bundles for batch activation as a set with the well know features of Risafi for batch activation of cards at a merchant terminal with the motivation to achieve the combined predictable results that each have individually.

The combination of Goldstein and Risafi does not specifically disclose "entering a total number of n cards" and "comparing the entered n number of cards with the calculated number of cards" and "if they match activating the n number of cards", however SEHR in at least paragraph [0126] discloses a POS which calculates a visitor's age based on the entry of a date-of-birth (DOB) and the present date and compares the calculated number (age) to a specific number to determine if a POS transaction may be completed. Therefore, it would have been obvious to modify the

Goldstein and Risafi combination with SEHR's POS which can perform simple math calculations, compare the result to a specific number and if the numbers compare activating the POS to complete the transaction (activation of the set of gift cards) with the motivation to inform the consumer if n gift cards will be activated.

- **Entering a total number of n cards to be activated into the POS device;**

The combination of Goldstein and Risafi does not specifically disclose "entering a total number of n cards", however it would have been obvious, at the time of the invention, to one of ordinary skill, to modify the combination of Goldstein and Risafi to enter the number of cards which they wish activated with the motivation to inform the POS operator of the number of cards to activate and charge the consumer for the activation.

Claim 6:

With regard to the limitations:

- **Activating a number of successively numbered cards at a POS device.**

Goldstein does not specifically disclose activating at a POS device; however Goldstein in at least Column 1, lines 55-67 discloses that a customer may purchase large groups of transaction cards from a card manufacturer so there are no unexpected, duplicate or missing cards. Goldstein in at least Column 2, lines 21-33 further discloses that the cards may be arranged and packaged in a specific sequence to allow for easier batch activation of cards. Goldstein in at least Column 3, lines 19-45 discloses that a retailer may easily identify and activate multiple cards at one time since the cards may be provided in contiguous sets (e.g. bundle, sleeve, etc.) of cards and/or in a known sequence. As a result, the retailer may retrieve an entire set of cards and activate all the cards at once **without having to individually activate each card**. Risafi in at least Column 4, lines 61-67, Column 5, lines 1-10, Fig. 5b, Fig. 7b, Column 6, lines 37-46, Column 8, lines 53-54, Column 9, lines 9-19, lines 35-41 discloses the batch activation of a set of cards at a merchant terminal (POS, ATM, etc.). Risafi in at least Column 6, lines 48-57 discloses a consumer purchasing a pre-paid card at a POS. Therefore, it would have been obvious, at the time of the

invention, to one of ordinary skill to combine the well-known features of Goldstein for producing

and packing cards in bundles for activation as a set with the well know features of Risafi for batch

activation of cards at a merchant terminal with the motivation to achieve the combined predictable

results that each have individually.

- *Entering a total number of n cards to be activated into the POS device;*

The combination of Goldstein and Risafi does not specifically disclose "entering a total number of

n cards", however it would have been obvious, at the time of the invention, to one of ordinary skill,

to modify the combination of Goldstein and Risafi to enter the number of cards which they wish

activated with the motivation to inform the POS operator of the number of cards to activate and

charge the consumer for the activation.

- *Communicating said first indicator and said total number of cards to an activation*
  computer and receiving confirmation that the activation has been approved.

Risafi in at least Column 4, lines 61-67 and Column 5, lines 1-10 discloses batch activation cards

by communicating a card number, PIN and initial balance to a card processing center, the cards

being activated and distributed to the user(s).

Claims 3-5 and 7-8:

With regard to the limitations:

- *Cards are activated in a sequence.*

- *Cards are deactivated in a sequence.*

- *Request for activation is acknowledged based on the first indicator and the total*
  number of cards.

Goldstein does not specifically disclose the flow of the activation request from a POS terminal to

the activation processor per se. However, Goldstein in at least Column 3, lines 16-45 discloses

that a retailer may easily identify and activate multiple cards at one time since the cards may be

provided in contiguous sets and/or in a known sequence. Also disclosed is that the first and last

cards in a series may be identified to the card tracking database and all cards located in the set

between the first and last identified cards in the series may be activated. Goldstein in at least Column 9, lines 40-63 further discloses the use of an audit trail to deactivate a group of cards.

Risafi in at least Column 4, lines 61-67, Column 5, lines 1-10, Fig. 5b, Fig. 7b, Column 6, lines 37-46, Column 8, lines 53-54, Column 9, lines 9-19, lines 35-41 discloses the batch activation of a set of cards at a merchant terminal (POS, ATM, etc.). Risafi in at least Column 9, lines 9-18, Column 12, lines 32-35, card recipients being notified of the PIN associated with their card via email, electronic means or other means. Risafi in at least Column 12, lines 65-67 further discloses transmitting to the program sponsor that the card accounts have been activated. Goldstein/Risafi do not specifically disclose that during a batch activation acknowledgement is received based on the first indicator and the total number of cards per se, however it would have been obvious to modify Goldstein/Risafi batch activation of cards with a notification indicating that the request for activation has been acknowledged and approved with the motivation of notifying the retailer and the customer that some cards are missing, mutilated, etc. in order to correct the deficiencies or that the cards have been successfully activated..

Therefore, it would be obvious, at the time of the invention, to one of ordinary skill to further modify the Goldstein / Risafi combination with a process to deactivate (void) a sequence of cards by inputting the necessary data to determine the sequence of cards (start and ending number of a sequence, start number of a set of cards and the number of cards in the set, etc.) to be deactivated.

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein et al., US 7,028,896 B2 ("Goldstein") in view of Risafi et al. US 6,473,500 B1 ("Risafi").

Claim 21:

With regard to the limitations:

- *Providing a plurality of cards having sequential card numbers, wherein the plurality of cards are secured within a common package that holds the plurality of cards together as a set;*

- *Scanning with a scanner at a POS device a first card number from a first card of the set, wherein the first card number is scanned while the plurality of cards are secured with the package; and*

- *Electronically reading the last card number of a last card from the set;*

- *Activating each of the plurality of cards based on the first card number from the first card and the last card number of the last card.*

Goldstein in at least Column 9, lines 30-63 and Fig.2 discloses that the cards are arranged in a desired way and may be organized in a hierarchy for packaging, and the location of cards in the hierarchy may be verified and controlled. Packaging of cards in sets or sleeves and each card being associated with a particular sleeve, box and pallet based on the card's identifier or other information. Goldstein in at least Column 3, lines 19-45 discloses that a retailer may easily identify and activate multiple cards at one time since the cards may be provided in contiguous sets (e.g. bundle, sleeve, etc.) of cards and/or in a known sequence. As a result, the retailer may retrieve an entire set of cards and activate all the cards at once **without having to individually activate each card**. Goldstein in at least Column 9, lines 64-67 and Column 10, lines 1-67 further discloses additional packaging information regarding card identifiers and tracking of the identifier versus the packaging. Goldstein in at least Column 11, lines 21-55 still further discloses sleeves being labeled (tamper-evident seal) with a sleeve number, the range of cards included in the sleeve, the customer, a job description and any other suitable material.

Goldstein in at least Column 14, lines 60-67 and Column 15, lines 1-20, lines 42-67 discloses a sleeve for bundling a set of card having an identifier for the first and last cards in the sleeve that may be read with a bar code reader.

Risafi in at least Column 4, lines 61-67, Column 5, lines 1-10, Fig. 5b, Fig. 7b, Column 6, lines 37-46, Column 8, lines 53-54, Column 9, lines 9-19, lines 35-41 discloses the batch activation of a set of cards at a merchant terminal (POS, ATM, etc.).

Goldstein/Risafi do not specifically disclose that during a batch activation is based scanning the first and last card number, however it would have been obvious to modify Goldstein/Risafi batch activation of cards by scanning the card identifiers provided on the card sleeve by Goldstein with the motivation to allow the fast activation of a set of packaged (sleeved) cards.

Claim 22:

With regard to the limitations:

- ***Providing as a package a plurality of cards, each of said cards having a different respective card number and wherein said card numbers form a sequential order;***

- ***Providing a package identifier on said package detectable at a POS device;***

Goldstein in at least Column 9, lines 30-63 and Fig.2 discloses that the cards are arranged in a desired way and may be organized in a hierarchy for packaging, and the location of cards in the hierarchy may be verified and controlled. Packaging of cards in sets or sleeves and each card being associated with a particular sleeve, box and pallet based on the card's identifier or other information. Goldstein in at least Column 3, lines 19-45 discloses that a retailer may easily identify and activate multiple cards at one time since the cards may be provided in contiguous sets (e.g. bundle, sleeve, etc.) of cards and/or in a known sequence. As a result, the retailer may retrieve an entire set of cards and activate all the cards at once **without having to individually activate each card**. Goldstein in at least Column 9, lines 64-67 and Column 10, lines 1-67 further discloses additional packaging information regarding card identifiers and tracking of the identifier versus the packaging. Goldstein in at least Column 11, lines 21-55 still further discloses sleeves being labeled (tamper-evident seal) with a sleeve number, the range of cards included in the sleeve, the customer, a job description and any other suitable material.

- ***Wherein said package identifier comprises:***

  o ***A first indicator indicating a first card number card; and***

  o ***A second indicator indicating a total number of cards in said package for activation of the plurality of cards without entering into the POS device any card numbers except the first card number.***

Goldstein in at least Column 14, lines 60-67 and Column 15, lines 1-20, lines 42-67 discloses a sleeve for bundling a set of card having an identifier for the first and last cards (range of cards) in the sleeve that may be read with a bar code reader. Goldstein in at least Column 9, lines 30-63 discloses that cards may be packaged in sleeves of a varying amount of cards with each sleeve having two or more cards.

Risafi in at least Column 4, lines 61-67, Column 5, lines 1-10, Fig. 5b, Fig. 7b, Column 6, lines 37-46, Column 8, lines 53-54, Column 9, lines 9-19, lines 35-41 discloses the batch activation of a set of cards at a merchant terminal (POS, ATM, etc.).

Goldstein/Risafi do not specifically disclose that during a batch activation is on based scanning the first indicator indicating a first card number and a second indicator representing the total number of cards in a package, however it would have been obvious to modify Goldstein/Risafi batch activation of cards by scanning the card identifiers provided on the card sleeve by Goldstein and to modify Goldstein's range of cards to be an indicator representing the total number of cards in the sleeve with the motivation to allow the fast activation of a set of packaged (sleeved) cards.

Claim 23:

With regard to the further limitation of Claim 21:

- ***Wherein the package is configured so that at least one of the card numbers can be detected by the scanner.***

Goldstein in at least Column 14, lines 60-67 and Column 15, lines 1-20, lines 42-67 discloses a sleeve for bundling a set of card having an identifier for the first and last cards in the sleeve that may be read with a bar code reader.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/
Primary Examiner, Art Unit 3627